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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/021,421	02/10/1998	RUSSEL T. JORDAN	399037	4431
30955	7590	06/16/2005	EXAMINER	
LATHROP & GAGE LC 4845 PEARL EAST CIRCLE SUITE 300 BOULDER, CO 80301			COOK, REBECCA	
			ART UNIT	PAPER NUMBER
			1614	

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/021,421

Applicant(s)

JORDAN ET AL.

Examiner

Rebecca Cook

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 14-21, 34-37 and 39-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 14-21, 34-37 and 39-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 3, 2005 has been entered.

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it is not signed by the applicants.

### ***Claim Rejections - 35 USC § 112***

Claims 20-21 and 51-52 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for nordihydroguaiaretic acid and ascorbic acid, does not reasonably provide enablement for nordihydroguaiaretic acid derivatives, nordihydroguaiaretic acid functional homologues, ascorbic acid derivatives and functional homologues of ascorbic acid. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

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The specification does not disclose what compounds would be included in the scope of the words "derivatives" and "functional homologues." Is the intent to include such compounds as those having heterocyclic moieties, various salts? It would take undue experimentation to determine which nordihydroguaiaretic acid derivatives, nordihydroguaiaretic acid functional homologues, ascorbic acid derivatives and functional homologues of ascorbic acid would yield the desired result.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by 4766,113 (West et). West discloses (column 9, lines 10-12) that a commercially available composition of 10% Cu 2+ and 8-hydroxy quinolone is available.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7,14-21,34-37 and 39-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/03032 (Unilever). Unilever (page 11, page 14) discloses a composition comprising 8-hydroxyquinoline and Zn 2+. The instant composition differs

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over Unilever in reciting at least five percent by weight of 8-hydroxyquinoline and Zn.

Dependent claims recite ratios of 8-hydroxyquinoline to Zn, a gel base, and specific penetrants and antioxidants.

However, Unilever discloses that the vehicle ranges from 2 to 99%, functioning to deliver active ingredients. It would be obvious to one of ordinary skill in the art that the difference between the vehicle and 100% would be the amount of active ingredient, which would therefore be between 1 to 98%. Additionally, once a composition is known in the art it is within the skill of the artisan to determine the optimum ratios of ingredients and forms of the composition.

Furthermore, penetrants and antioxidants are well-known in the composition art and Unilever discloses (page 18) that other components may be incorporated into the compositions. Moreover, Unilever discloses (page 15) that copolymers of polyoxyalkylene ethers are useful in the composition, which would yield the instant gel base. It also discloses that vitamin C (page 18) can be included in the composition. In the absence of a showing of unexpected results no unobviousness is seen in the instant penetrants and antioxidants, since they are well-known in the composition art and Unilever discloses that other components may be incorporated into its compositions.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,124,374 (Koliass et al). Koliass discloses (abstract, column 4) a composition comprising 8-hydroxy quinoline and Cu <sup>2+</sup>.

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The instant composition differs over Unilever in reciting at least five percent by weight of 8-hydroxyquinoline and Zn. Dependent claims recite ratios of 8-hydroxyquinoline to Zn, a gel base, and specific penetrants and antioxidants.

However, Koliadis discloses that the ingredients may comprise any amount that is effective and once a composition is known in the art it is within the skill of the artisan to determine the optimum amounts and ratios of ingredient.

In view of Applicants' argument the earlier rejection over EP 506 207 is withdrawn.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 14-21, 34-37 and 39-52 are again rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 10/247,161. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given in the Paper of April 26, 2004.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. It is noted that applicants have not argued this rejection, but appear to acquiesce in it.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cook whose telephone number is (571) 272-0571. The examiner can normally be reached on Monday through Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (571) 272-0951.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Renee Jones (571) 272-0547 in Customer Service.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The official fax number is 571-273-8300.

Rebecca Cook



Primary Examiner  
Art Unit 1614

June 13, 2005